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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,065	10/16/2003	Christopher R. McGee	020375-033110US	8138
20350 7590 01/22/2009 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER CARLSON, JEFFREY D	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 01/22/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/688,065

**Applicant(s)**

MCGEE ET AL.

**Examiner**

Jeffrey D. Carlson

**Art Unit**

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/02)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

1. This action is responsive to the paper(s) filed 10/21/08.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fravel (US2003/0130889).**
4. Regarding claims 1, 4, Fravel teaches systems and methods for offering and redeeming coupons electronically [abstract]. Users are provided with a coupon card that includes only the user's account identification and does not itself store coupons or coupon files/descriptions [0022]. This account identifier is associated with a collection of coupons which are stored at a central server [0008] (a storage of discount-arrangement information including an inherent description of the applicable discount). To redeem a coupon, the customer presents his card at a POS; the POS then forwards the account identifier to the coupon server. Any coupons in that identified account are then compared to the products being purchased and where matches are made, the coupons are redeemed for the appropriate discount (i.e. the discount arrangement information including discount values are executed) and the POS completes the discounted transaction [0025]. Fravel states that retailers may create/define coupons

(discount arrangement information/pricing) at the server [0029]; these retailer-coupons are taken to be specific to that retailer and can only be redeemed at that retailer. Each retailer participating in the system must have a retailer account [0020]. Fravel does not mention that a merchant identification is sent to the host when a merchant POS accesses the host in association with a consumer presenting his card during a transaction. However Fravel teaches that retailers can request reimbursement during each consumer's transaction [0030] and it would have been obvious to one of ordinary skill at the time of the invention to have transmitted not only the user's account number but also the retailer's account number so that the appropriate retailer account can be accessed and subsequently attributed to the redemption and reimbursement. Further, for retailer-specific coupons, it would have been obvious to one of ordinary skill at the time of the invention to have identified the retailer to the host so that the host can return only relevant coupons (i.e. that coupons for that specific retailer), thus avoiding retailer redemption of another retailer's coupon. This therefore provides determination by the host whether the merchant is one of the plurality of approved merchants and returning validation information concerning the merchant determination.

5. Regarding claims 2, 3, in the case where the merchant identification is not found at the server or that there are no retailer-specific coupons to return, it would have been obvious to one of ordinary skill at the time of the invention to have provided an indication that the merchant is not one of the plurality and that no discount will be provided.

6. Regarding claims 5-7, it would have been obvious to one of ordinary skill at the time of the invention to have kept records for all transaction requests as a matter of good record keeping. Any of the data in the stored redemption records can be taken to be "criteria" (for initiating of marketing efforts). Further, it would have been obvious to one of ordinary skill at the time of the invention to have reminded merchants who lack coupons of the ability to create coupons with the system.

7. Regarding claims 8-11, it would have been obvious to one of ordinary skill at the time of the invention to have provided retailers reports that summarize coupon totals in support of the reconciliation process. This would enable the retailers to confirm that they have been properly credited for discounts and that the retailer transactions records match records provided by the system of Fravel for business purposes such as taxes, company audits, financial reports and balancing of the books.

8. Claims 12-21 are rejected with the same reasoning as claims 1-11 respectively.

9. **Claims 1-21 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Fravel (US2003/0130889) as above and further in view of Fajkowski (US5905246).**

10. Regarding claims 1-21, Fajkowski also teaches systems and methods for redeeming electronic coupons [abstract]. Fajkowski describes that coupon redemption has typically involved various problems including retailer mal-redemption where unscrupulous retailers fraudulently request reconciliation for coupons that were not actually used in an actual discounted transaction. For this reasons suspend lists are

kept for merchants to prevent further redemption fraud [col 3: lines 16-20]. Therefore it would have been obvious to one of ordinary skill at the time of the invention to have the system and methods of Fravel include a step of verifying the merchant's identify at the central host for each requested transaction so that a centrally managed "suspend list" can be used to prevent fraud.

11. The other claim limitations in the claims are addressed similarly to the obviousness rejection above using Fravel alone.

### ***Response to Arguments***

12. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Monday-Fridays; off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey D. Carlson/  
Primary Examiner, Art Unit 3622

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